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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/517,667 | 12/13/2004 | Kenji Ishii | Q84706 | 1902 |

23373 7590 04/04/2006

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EXAMINER

PUTTLITZ, KARL J

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1621

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/517,667

Applicant(s)

ISHII ET AL.

Examiner

Karl J. Puttlitz

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>Various</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

A cross reference to the counterpart PCT Application is required in the first sentence of the Specification.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the counterpart PCT application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what n of Y¹'s or m of Y²'s refers to in claim 1.

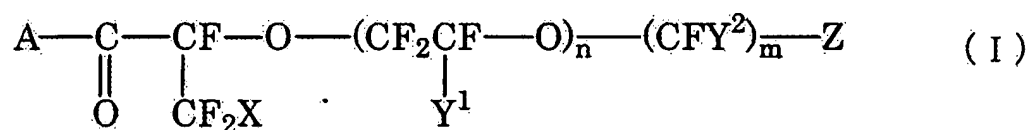
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

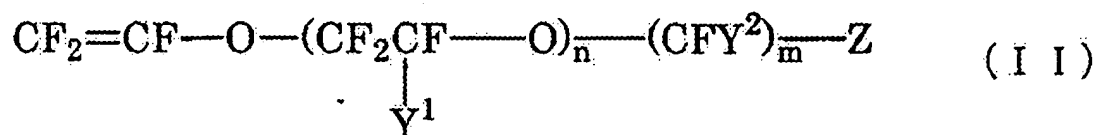
Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,649,790 to Tatemoto (Tatemoto).

The rejected claims cover a method for producing a water-soluble fluorine-containing vinyl ether which comprises subjecting a fluorine-containing 2-alkoxypropionic acid derivative represented by the following general formula (I):



[see definitions in claim 1]

to thermal decomposition at a temperature of not lower than 50°C but lower than 170°C in the presence of a coordinating organic solvent to give a water-soluble fluorine-containing vinyl ether represented by the following general formula (II):



[see definitions in claim 1]

said coordinating organic solvent having a coordinating property with an ion of said M^1 or an ion of said M^2 and said coordinating organic solvent being in an amount of 10 to 1,000 parts by mass per 100 parts by mass of said fluorine-containing 2-alkoxypropionic acid derivative.

The rejected claims also cover those embodiments specifying the wherein the hydrophilic group.

The rejected claims also cover those embodiments the thermal decomposition is carried out at a temperature not lower than 50°C but lower than 150°C.

The rejected claims also cover those embodiments wherein the coordinating organic solvent is in an amount of 30 to 300 parts by mass per 100 parts by mass of the fluorine-containing 2-alkoxypropionic acid derivative.

The rejected claims also cover those embodiments wherein the coordinating organic solvent comprises an aprotic polar organic solvent; and wherein the aprotic polar organic solvent is an ether solvent, sulfolane, hexamethylphosphoric triamide, acetonitrile, dimethylformamide, dimethyl sulfoxide, ethyl acetate and/or tetramethylurea; and wherein the ether solvent is a glyme-based solvent, a diethyl ether, a diisopropyl ether, tetrahydrofuran, dioxane, anisole and/or a crown ether. The

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glyme-based solvent is dimethoxyethane, diethoxyethane, monoethylene glycol dimethyl ether, diethylene glycol dimethyl ether, triethylene glycol dimethyl ether, tetraethylene glycol dimethyl ether, diethylene glycol monomethyl ether and/or diethylene glycol monoethyl ether. The aprotic polar organic solvent is a glyme-based solvent.

The rejected claims also cover those embodiments wherein the aprotic polar organic solvent has a water content not exceeding 250 ppm.

The rejected claims also cover those embodiments wherein the aprotic polar organic solvent is diethylene glycol dimethyl ether; and wherein the diethylene glycol dimethyl ether has a water content not exceeding 250 ppm.

The rejected claims also cover those embodiments wherein the fluorine-containing 2-alkoxypropionic acid derivative represented by the general formula (I) has a water content not exceeding 0.1% by mass.

The rejected claims also cover those embodiments wherein n is 0 or 1.

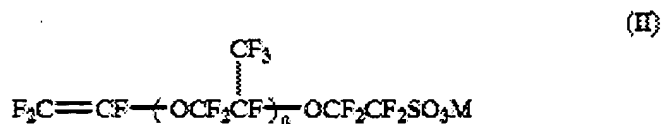
The rejected claims also cover those embodiments wherein Z is $-\text{SO}_3\text{M}^3$ or $-\text{SO}_3\text{M}^{4}_{1/2}$.

The rejected claims also cover those embodiments specifying Z and wherein Y^1 is a trifluoromethyl group, Y^2 is a fluorine atom and m is 2.

The rejected claims also cover those embodiments wherein n is 0.

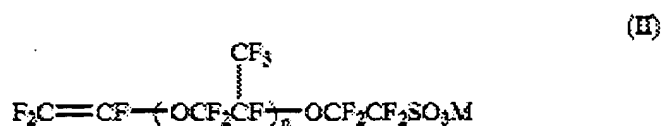
With regard to the above embodiments, Tatemoto teaches a process for preparing a perfluorovinylethersulfonic acid derivative represented by formula (II):

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[wherein M represents an alkali metal or alkaline earth metal; and n is 0, 1 or 2.]

by pyrolysis of a compound represented by formula (I) below:



[wherein M and n are as defined above], the pyrolysis being conducted in the presence of a catalyst which has coordinating properties to a metal ion M. See column 2, lines 19-40.

Specifically, the catalyst which has coordinating properties to a metal ion M is a glyme-based compound. In particular, the glyme-based compound is diethylene glycol dimethyl ether. See description bridging columns 2 and 3. In this same regard, the catalyst which has coordinating properties to a metal ion M is added in an amount of about 0.1 to about 1000 parts by weight relative to 100 parts by weight of a starting compound represented by formula (I). See column 3, lines 7-15.

Tatemoto teaches that pyrolysis is conducted generally at about 100°C or higher. See column 4, lines 30-35. Tatemoto does not indicate that water is present (see claims 12 and 13).

The difference between the process set forth in the rejected claims and the process set forth in the rejected claims is that while the instant claims require that the

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organic solvent be coordinating with regard to the metal "M", Tatemoto teaches that the coordinating component is a catalyst. However, as mentioned above, Tatemoto teaches that these components are the same, i.e., a glyme-based compound, in particular, diethylene glycol dimethyl ether. Moreover, the amounts of the coordinating component are the same: Tatemoto teaches amounts of 0.1 to about 1000 parts by weight relative to 100 parts by weight of a starting compound while the instant claims require 30 to 300 parts by mass per 100 parts by mass of the fluorine-containing 2-alkoxypropionic acid derivative. Therefore, notwithstanding the fact that Tatemoto teaches additional solvents not required by the claims, the disclosed coordinating components are the same, despite being a solvent or catalyst. In this connection, the claimed requirement that the organic solvent be coordinating with regard to the metal "M" is well within the motivation of those of ordinary skill, based on Tatemoto. Accordingly, the rejected claims are prima facie obvious in view of Tatemoto since this reference teaches the elements of the rejected claims with a reasonable expectation of success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at telephone number (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl J. Puttlitz
Assistant Examiner